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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,604	03/01/2007	Masanori Suzuki	288231US0PCT	4206

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EXAMINER	
FERGUSON, LAWRENCE D	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
04/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/574,604	SUZUKI ET AL.	
	Examiner	Art Unit	
	LAWRENCE D. FERGUSON	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/22/09*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 11-20* is/are pending in the application.

4a) Of the above claim(s) *12-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 11 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 March 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/5/06;6/28/06;11/15/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references disclosed within the information disclosure statements (IDS) submitted on November 15, 2007, June 28, 2006, and April 5, 2006, have been considered and initialed by the Examiner.

Response to Election

3. This action is in response to the provisional election mailed December 23, 2008. (Group I) Claims 1-7, 11 and 17-20 were elected with traverse rendering (Group II) Claims 12-16 withdrawn as a non-elected invention.

RESPONSE TO REQUEST FOR RECONSIDERATION

4. Applicant's election with traverse of method of making an optical recording medium (Group II) is acknowledged. The traversal is on the ground(s) that 'if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims distinct or

independent inventions.' M.P.E.P. 803. The search of the two classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every elastomer film is not made using the same method steps. Applicant further argues the inventions as a whole have not been considered. Both inventions as a whole were considered and it was determined that every elastomer film is not made using the same method steps every mixture is not simply coated, but can be applied by alternative means.

The requirement is deemed proper and is therefore made **FINAL**.

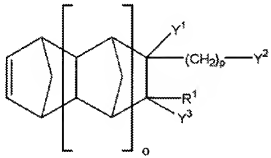
Obvious Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, 5-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 7,163,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include an elastomer film (sheet) having a polar group modified olefin based copolymer, such as a carboxyl group, along with a metal. They both also include a thickness of 0.5mm, where U.S. Patent No. 7,163983 has a thickness in the range of 10μm to 2cm (0.01mm to 20mm). Because the elastomer film of U.S. Patent No. 7,163983 comprises similar material including the same general formula (1) :



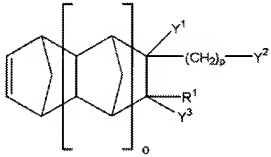
(1)

[in the general formula (1), R1 represents a hydrogen atom or a hydrocarbon group of 1 to 10 carbon atoms; each of Y1, Y2 and Y3 represents independently a hydrogen atom, a hydrocarbon group of 1 to 10 carbon atoms or carboxyl group; at least one of Y1, Y2 and Y3 is carboxyl group and, in a case where two or more of Y1, Y2 and Y3 are carboxyl groups, they be an acid anhydride formed by linkage with one another, o represents an integer from 0 to 2 and p represents an integer from 0 to 5.].

as the instantly claimed invention, it would have been obvious to one of ordinary skill in the art for the elastomer sheet to have a total transmittance of 90% or higher at a temperature of 25˚C.

Obvious Double Patenting

7. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,670,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include an elastomer having a polar group modified olefin based copolymer, such as a carboxyl group, along with a metal. Because the elastomer film of U.S. Patent No. 6,670,426 comprises similar material including the same general formula (1) :



(1)

[in the general formula (1), R1 represents a hydrogen atom or a hydrocarbon group of 1 to 10 carbon atoms; each of Y1, Y2 and Y3 represents independently a hydrogen atom, a hydrocarbon group of 1 to 10 carbon atoms or carboxyl group; at least one of Y1, Y2 and Y3 is carboxyl group and, in a case where two or more of Y1, Y2 and Y3 are carboxyl groups, they be an acid anhydride formed by linkage with one another, o represents an integer from 0 to 2 and p represents an integer from 0 to 5.].

as the instantly claimed invention, it would have been obvious to one of ordinary skill in the art for the elastomer sheet to have a total transmittance of 90% or higher at a temperature of 25°C.

Claim Rejections – 35 USC § 103(a)

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-4, 6 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duck et al (U.S. 3,703,566).

Duck discloses an elastomeric composition comprising a polar compound comprising an ethylene/olefin copolymer (column 1, lines 15-29, 36-50 and column 2, lines 24-52) that is modified with a metal alkoxide (column 3, lines 15-37). Because Duck discloses an elastomeric composition comprising a polar group modified olefin-based copolymer and a metal oxide, it would have been obvious to one of ordinary skill in the art for the elastomer to have a total transmittance of 90% or higher at a temperature of 25°C. Additionally, although Duck does not disclose a thickness of the elastomer material, thickness is optimizable. It would have been obvious to one of ordinary skill in the art to optimize the thickness of the elastomer material since the thickness directly affects the durability of the material and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Additionally, it would have been obvious to one of ordinary skill in the art for the thickness to be very thin, such as

0.5mm in order for the material to be used with various articles and to reduce the manufacturing cost of the elastomer material, as in claim 1.

Concerning claim 2, Duck discloses the material includes a carboxyl group (column 4, lines 54-61).

Concerning claim 3, Duck discloses the material includes an ethylene/1(alpha)-olefin copolymer (column 2, lines 37-52).

Concerning claim 4, the phrase, "obtained by copolymerizing one type of two or more olefin-based monomers, and one type or two or more unsaturated monomers having a polar group introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claim 6, the elastomer material is not crosslinked.

Concerning claim 17, the phrase, "for display panel" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

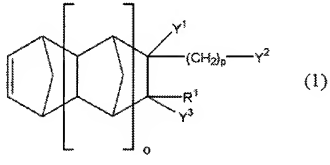
prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Concerning claim 18, the elastomer material is not crosslinked.

Claim Rejections – 35 USC § 103(a)

10. Claims 5, 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duck et al (U.S. 3,703,566) in view of Oshima et al (EP 1113027).

Duck is taken as above. Duck does not disclose the elastomer material being crosslinked or comprising a general formula, such as



(1)

[in the general formula (1), R1 represents a hydrogen atom or a hydrocarbon group of 1 to 10 carbon atoms; each of Y1, Y2 and Y3 represents independently a hydrogen atom, a hydrocarbon group of 1 to 10 carbon atoms or carboxyl group; at least one of Y1, Y2 and Y3 is carboxyl group and, in a case where two or more of Y1, Y2 and Y3 are carboxyl groups, they be an acid anhydride formed by linkage with one another, o represents an integer from 0 to 2 and p represents an integer from 0 to 5.].

Oshima teaches an elastomer composition comprising a modified ethylene/alpha-olefin copolymer (paragraph 0002 and paragraphs 0008-0014) which is crosslinked with a crosslinking agent (claim 10) which comprises an unsaturated

monomer have a general formula similar to that of the instantly claimed formula, which further comprises a carboxyl group:

wherein X^1 and X^2 mean, independently of each other, a hydrogen atom, a hydrocarbon group or the following specific functional group, at least one of X^1 and X^2 is the specific functional group, R^1 and R^2 denote, independently of each other, a hydrogen atom or a hydrocarbon group having 1 to 10 carbon atoms, one of R^1 and R^2, which is bonded to a carbon atom to which the specific functional group is bonded, is the hydrocarbon group having 1 to 10 carbon atoms, and n stands for an integer of 0 to 2;

Specific functional group:

[0020] a functional group selected from the group consisting of a hydroxyl group, a hydrocarbon group to which a hydroxyl group is bonded, a carboxyl group, a hydrocarbon group to which a carboxyl group is bonded, a primary or secondary amino group, a hydrocarbon group to which a primary or secondary amino group is bonded, a quaternary ammonium salt of a primary or secondary amino group and a hydrocarbon group to which a primary or secondary amino group is bonded, an amide group having at least one active hydrogen atom bonded to a nitrogen atom, a hydrocarbon group to which such a amide group is bonded, and an imide group composed of X^1 and X^2 and represented by -CO-NH-CO-.

Duck and Oshima are combinable because they are both related to elastomer compositions. It would have been obvious to one of ordinary skill in the art to substitute the crosslinked olefin copolymer of Oshima for the olefin copolymer of Duck to achieve the predictable result of improving the printability and durability of the elastomeric material (paragraph 0001 of Oshima) as in claim 5.

Concerning claims 7 and 19, the phrase, "formed by electron beam irradiation, UV-ray irradiation and a crosslinking agent" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Claim Rejections – 35 USC § 103(a)

11. Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duck et al (U.S. 3,703,566) in view of Kawamoto et al (U.S. 4,968,752)).

Duck is taken as above. Duck does not disclose the elastomer material having another layer on at least one surface of the elastomer material. Kawamoto teaches an olefin copolymer thermoplastic elastomer (column 1, lines 5-13, column 2, lines 10-17) where the copolymer comprises at least one crosslinked alpha-olefin and ethylene compound (column 3, lines 43-64) which is laminated with an additional sheet (film) (column 10, lines 24-31). Duck and Kawamoto are combinable because they are both related to a similar field, which is elastomeric materials having olefin copolymers. It would have been obvious to one of ordinary skill in the art to have included a sheet (layer) on one of the surfaces of the elastomeric material of Duck, as taught in Kawamoto to achieve the predictable result of improving the scratch resistance of the elastomer material (column 2, lines 5-8 of Kawamoto), as in claims 11 and 20.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil, can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/
Patent Examiner, Art Unit 1794

/JENNIFER MCNEIL/

Supervisory Patent Examiner, Art Unit 1794